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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,007	03/07/2005	Klaus Schoeller	DE 020204	1124

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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

WALFORD, NATALIE K

ART UNIT	PAPER NUMBER
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2879

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/527,007	Applicant(s) SCHOELLER ET AL.	
	Examiner Natalie K. Walford	Art Unit 2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/05 and 11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claims 2, 4, 5, and 6 are objected to because of the following informalities:

Claim 2 recites the limitation "the color point" and "the CIE 1931 diagram" in the second and third lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the color temperature" in the second and third lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the luminous efficacy" in the second and third lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the color point change" in the second and third lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation in line 5 AND 7, and the claim also recites in line 4 AND 6, which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim

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indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation line 4, and the claim also recites in line 5, which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation in line 4, and the claim also recites in line 5, which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP §

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2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation line 4, and the claim also recites in line 6, which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 4-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Muto (US 6,670,765).

Regarding claim 1, Muto discloses a high-pressure discharge lamp (item 10) in figure 1 comprising: an inner vessel with a discharge chamber (item 2), with at least two electrodes (item 3) extending into the discharge chamber, and possibly an outer bulb (item 1) surrounding the inner vessel, characterized in that the discharge chamber contains an ionizable filling

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comprising: at least one rare gas (column 9, lines 45-47), 0 mg to 10 mg of mercury (column 11, lines 37-41) and a metal halide mixture comprising: 40 to 80% by weight of sodium halide (column 9, line 40), 25 to 55% by weight of scandium halide (column 9, line 40), 1 to 15% by weight of indium halide (column 5, lines 23-26), and 0 to 34% by weight of thallium halide.

Regarding claim 2, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the color point of the light emitted by the high-pressure discharge lamp in the CIE 1931 diagram has an X-color coordinate in a range from 0.345 to 0.375, preferably from 0.350 to 0.370, more preferably from 0.355 to 0.360 (FIG. 8), and a Y-color coordinate in a range from 0.350 to 0.375, preferably from 0.355 to 0.370, more preferably from 0.360 to 0.365 (FIG. 8).

Regarding claim 4, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the color temperature of the light emitted by the high-pressure discharge lamp lies in a range from 4300 K to 5000 K, preferably from 4500 K to 4900 K, more preferably from 4700 K to 4800 K (FIGS. 7 and 8 and column 10, lines 21-35).

Regarding claim 5, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the luminous efficacy of the light emitted by the high-pressure discharge lamp is at least 70 lm/W, preferably ≥ 75 lm/W, more preferably ≥ 85 lm/W, even more preferably ≥ 95 lm/W (FIGS. 5 and 7 and column 9, lines 15-17).

Regarding claim 6, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the color point change with respect to the X-color coordinate and the Y-color coordinate amounts to $\leq 6\%$, preferably $\leq 5\%$, preferably $\leq 4\%$, more preferably $\leq 3\%$,

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particularly preferably $\leq 2\%$, and most preferably $\leq 1\%$ over a period of operation of the high-pressure discharge lamp of 1500 hours (FIGS. 7 and 8).

Regarding claim 7, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the ionizable filling comprises: at least one rare gas, preferably xenon (column 9, lines 45-47), 50 to 70% by weight of sodium iodide (column 9, line 40), 30 to 50% by weight of scandium iodide (column 9, line 40), 1 to 15% by weight of indium iodide (column 5, lines 23-26), and 0 to 10 mg mercury (column 11, lines 37-41).

Regarding claim 8, Muto discloses a high-pressure discharge lamp as claimed in claim 1, characterized in that the ionizable filling comprises: at least one rare gas, preferably xenon (column 9, lines 45-47), 50 to 60% by weight of sodium iodide (column 9, line 40), 35 to 45% by weight of scandium iodide (column 9, line 40), 1 to 15% by weight of indium iodide (column 5, lines 23-26), and 0 to 10 mg mercury (column 11, lines 37-41).

Regarding claim 9, Muto discloses an ionizable filling, characterized in that said ionizable filling comprises: at least one rare gas, 0 mg to 10 mg of mercury (column 9, lines 45-47), and a metal halide mixture comprising: 40 to 80% by weight of sodium halide (column 9, line 40), 25 to 55% by weight of scandium halide (column 9, line 40), 1 to 15% by weight of indium halide (column 5, lines 23-26), and 0 to 34% by weight of thallium halide.

Regarding claim 10, Muto discloses a lighting unit, in particular a motor vehicle headlight (column 1, lines 9-16), comprising a high-pressure discharge lamp as claimed in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muto (US 6,670,765) in view of Akutsu et al. (US 4,047,069).

Regarding claim 3, Muto discloses a high-pressure discharge lamp as claimed in claim 1, but does not expressly disclose that the outer bulb comprises neodymium, preferably neodymium oxide, the neodymium oxide content being preferably 2 to 20% by weight with respect to the total weight of the outer bulb, as claimed by Applicant. Akutsu is cited to show a discharge lamp in figure 1 with a bulb (item 23) that contains neodymium (column 3, lines 47-48). Akutsu teaches that when neodymium oxide is present on the outer bulb, light transmissivity can be increased (FIG. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the outer bulb comprises neodymium, preferably neodymium oxide, the neodymium oxide content being preferably 2 to 20% by weight with respect to the total weight of the outer bulb, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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Contact Information

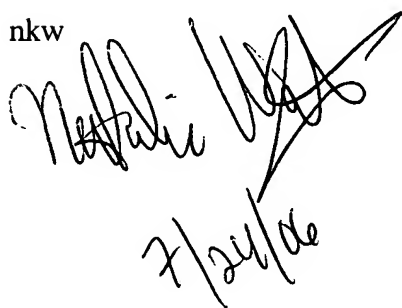
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie K. Walford whose telephone number is (571)-272-6012.

The examiner can normally be reached on Monday-Friday, 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on (571)-272-2457. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nkW



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S. Roy
7/24/06
Sikhar Roy
AU 2879